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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,543	02/17/2004	Moshe Flashner-Barak	1662/63202	3365

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EXAMINER	
ROYDS, LESLIE A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/781,543	FLASHNER-BARAK ET AL.	
	Examiner	Art Unit	
	Leslie A. Royds	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is /are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-19 are presented for examination.

Upon further consideration of the claimed subject matter, the restriction requirement of June 20, 2007 has been VACATED in lieu of the following requirement, which supersedes the previous requirement of June 20, 2007.

Requirement for Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-6, drawn to a composition for improving the bioavailability of a drug comprising at least one poorly bioavailable drug dissolved in an effective amount of menthol, classified in class 514, subclasses 26 and 724, depending upon the drug used.

II. Claims 7-12, drawn to methods for improving the bioavailability of a drug, classified in class 514, subclasses 460 and 724, depending upon the drug used.

III. Claims 13-16, drawn to a method for reducing the variability of the bioavailability of a drug, classified in class 514, subclasses 510 and 724, depending upon the drug used.

IV. Claims 17-19, drawn to a method for increasing the extent of time that a drug provides a therapeutically significant concentration in blood or plasma, classified in class 514, subclasses 182 and 724, depending upon the drug used.

The inventions are distinct, each from the other, for the following reasons:

Inventions I and II-IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP §806.05(h). In the instant case, the presently claimed pharmaceutical composition of Invention I can be used in a materially different process

of use, namely the use of a composition containing cyclosporine and menthol for treating organ rejection in patients having undergone organ transplantation, for example.

Inventions II-IV are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. Please reference MPEP § 806.05(j). In the instant case, Inventions II-IV are related because they require at least a step of dissolving a drug in an effective amount of menthol. However, the objective(s) of each of Inventions II, III and IV are unique and distinct from one another such that the steps required for each single method are not required for the other methods. Specifically, each of Inventions II, III and IV require an effective amount of menthol to achieve the claimed therapeutic purpose such that the amounts required to achieve each objective are distinct and unique to the desired objective. Accordingly, the modes of operation, functions and/or effects of the methods are clearly distinct from one another, despite the fact that the Inventions are related solely on the basis of the dissolution of a drug in an amount of menthol. In view of the fact that the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants, the inventions are properly held to be patentably distinct from one another.

Because these inventions are distinct for the reasons given above, they require a different field of search (see MPEP §808.02) and they have acquired a separate status in the art because of their recognized divergent subject matter, the requirement for examination purposes as indicated is proper.

Election of Species Requirement

This application contains claims directed to patentably distinct species of poorly bioavailable drug (claims 1, 7-8, 13 or 17) and methods for affecting bioavailability with or without administration to a mammal (claims 10 or 15).

The species are independent and/or distinct for the following reasons:

Regarding the species of poorly bioavailable drugs, the claimed compounds encompass such a breadth of compounds that are structurally and/or chemically distinct from any one single other compound encompassed by the claims such that a comprehensive search of the patent and non-patent literature for any one such compound would not necessarily result in a comprehensive search of any one or more of the other claimed compounds. In consideration of the number and significant chemical and structural variability of the claimed genera of poorly bioavailable compounds, the disparate nature and breadth of compounds encompassed by the claimed genera precludes a quality examination on the merits, not only because a burdensome search would be required for the entire scope of the claim(s), but also because the consideration of the findings of such a search for compliance with the statutes and requirements set forth under 35 U.S.C. 101, 102, 103 and 112, would be unduly onerous. Further, though Applicant has recognized a common functionality to the claimed compounds, e.g., that they exhibit poor bioavailability when administered *in vivo*, it remains that the art does not necessarily recognize the claimed compounds as equivalents or substantially interchangeable such that the discovery of one such compound in the prior art would anticipate, suggest or render obvious any one or more other compounds claimed. Additionally, it also remains that the art may recognize an advantageous use for combining the claimed poorly bioavailable drug with menthol that is not necessarily tied to its property of poor bioavailability.

Regarding the species of methods for affecting bioavailability with or without administration to a mammal, the species are distinct from one another because the claimed methods, in the absence of a step of administration of the composition to a mammal, read upon a method of using the claimed composition to effect an objective that is distinct from the objective of actually treating the mammal. However, when the claimed methods are combined with a method step of administering the composition to a mammal, it is noted that the objective of the method now encompasses the execution and effect of treating a mammal

with the claimed composition. Accordingly, the objective(s) of the claimed methods are distinct depending upon the inclusion or exclusion of this recited step of administration to a mammal.

Election of Invention I requires Applicant to make the following species elections:

Election of a **single disclosed specie** of poorly bioavailable drug from those specifically claimed (see, e.g., claims 2 and 4-6) **or** a generic poorly bioavailable drug not specifically claimed in present claims 2 and 4-6.

Should Applicant elect any one of (i) drug with low aqueous solubility, (ii) drug capable of being metabolized by cytochrome P450, (iii) drug capable of being expelled from cells by the P-glycoprotein pump, or (iv) drug capable of being metabolized via glucuronidation, as recited in present claim 2, Applicant is further required to elect a single disclosed specie of drug from the claimed genus.

For example, if Applicant elects a drug with low aqueous solubility, then Applicant must choose a **single disclosed specie** of drug capable of this function, such as, e.g., ketoprofen.

Applicant is cautioned that the election of a particular specie of poorly bioavailable drug, wherein the elected specie(s) is/are not adequately supported by the accompanying specification, may raise an issue of new matter under the written description requirement of 35 U.S.C. 112, first paragraph.

Election of Invention II requires Applicant to make the following species elections:

Election of a **single disclosed specie** of poorly bioavailable drug from those specifically claimed (see, e.g., claim 9) **or** a generic poorly bioavailable drug not specifically claimed in present claim 9.

Should Applicant elect any one of (i) drug with low aqueous solubility, (ii) drug capable of being metabolized by cytochrome P450, (iii) drug capable of being

expelled from cells by the P-glycoprotein pump, or (iv) drug capable of being metabolized via glucuronidation, as recited in present claims 9, Applicant is further required to elect a single disclosed specie of drug from the claimed genus.

For example, if Applicant elects a drug with low aqueous solubility, then Applicant must choose a **single disclosed specie** of drug capable of this function, such as, e.g., ketoprofen.

Applicant is further required to elect whether the method of Invention II directed to improving the bioavailability of a drug is practiced (A) WITHOUT a step of further administering the composition to a mammal or (B) WITH a step of further administering the composition to a mammal (claim 10).

Applicant is cautioned that the election of a particular specie of poorly bioavailable drug, wherein the elected specie(s) is/are not adequately supported by the accompanying specification, may raise an issue of new matter under the written description requirement of 35 U.S.C. 112, first paragraph.

Election of Invention III requires Applicant to make the following species elections:

Election of a **single disclosed specie** of poorly bioavailable drug from those specifically claimed (see, e.g., claim 14) **or** a generic poorly bioavailable drug not specifically claimed in present claim 14.

Should Applicant elect any one of (i) drug with low aqueous solubility, (ii) drug capable of being metabolized by cytochrome P450, (iii) drug capable of being expelled from cells by the P-glycoprotein pump, or (iv) drug capable of being metabolized via glucuronidation, as recited in present claim 14, Applicant is further required to elect a single disclosed specie of drug from the claimed genus.

For example, if Applicant elects a drug with low aqueous solubility, then Applicant must choose a **single disclosed specie** of drug capable of this function,

such as, e.g., ketoprofen.

Applicant is further required to elect whether the method of Invention II directed to improving the bioavailability of a drug is practiced (A) WITHOUT a step of further administering the composition to a mammal or (B) WITH a step of further administering the composition to a mammal (claim 15).

Applicant is cautioned that the election of a particular specie of poorly bioavailable drug, wherein the elected specie(s) is/are not adequately supported by the accompanying specification, may raise an issue of new matter under the written description requirement of 35 U.S.C. 112, first paragraph.

Election of Invention IV requires Applicant to make the following species elections:

Election of a **single disclosed specie** of poorly bioavailable drug from those specifically claimed (see, e.g., claim 18) **or** a generic poorly bioavailable drug not specifically claimed in present claim 18.

Should Applicant elect any one of (i) drug with low aqueous solubility, (ii) drug capable of being metabolized by cytochrome P450, (iii) drug capable of being expelled from cells by the P-glycoprotein pump, or (iv) drug capable of being metabolized via glucuronidation, as recited in present claim 18, Applicant is further required to elect a single disclosed specie of drug from the claimed genus.

For example, if Applicant elects a drug with low aqueous solubility, then Applicant must choose a **single disclosed specie** of drug capable of this function, such as, e.g., ketoprofen.

Applicant is cautioned that the election of a particular specie of poorly bioavailable drug, wherein the elected specie(s) is/are not adequately supported by the accompanying specification, may raise an issue of new matter under the written description requirement of 35 U.S.C. 112, first paragraph.

Note also that a reply electing a single GENUS of drugs for examination does not satisfy the

instructions set forth *supra* and will be held non-compliant for failing to elect a SINGLE DISCLOSED SPECIE of drug for examination on the merits.

Currently, claims 1-19 are generic.

Applicant is advised that a reply to this requirement is REQUIRED to include an identification of the single disclosed species of poorly bioavailable drug and, if applicable, whether the elected method is practiced in conjunction with an administration step, that is elected consonant with this requirement and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, Applicant must indicate which are readable upon the elected species. Please reference MPEP §809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though this requirement be traversed (37 C.F.R. 1.143) and (ii) an identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should Applicant traverse on the ground that the inventions or species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be

used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The Examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the Examiner withdraws the restriction requirement before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Royds whose telephone number is (571)-272-6096. The examiner can normally be reached on Monday-Friday (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571)-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Leslie A. Royds
Patent Examiner
Art Unit 1614

January 9, 2008

1/11/08

ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER